

## REMARKS

Entry of the foregoing amendments, and reexamination and reconsideration of the subject application, and in light of the following remarks, are respectfully requested.

### Amendments

Claims 1 and 9 have been amended to recite the film as consisting essentially of at least one of the oxides listed, support for which is found at least at page three (last paragraph), original claim 5, and the abstract.

### Rejection of Claims 1, 2, 4, 6, and 8-12 under 35 U.S.C. §112[1]

Claims 1 and 9 have been amended to recite that the film layer is made from a compound selected from the listed oxides, which is not meant to exclude combinations thereof.

The rejection alleges that there is no written description of a film having more than one of the listed oxides. To the contrary, page 3 (last paragraph) mentions that the film can be made by such processes as spraying and dipping. It is well known in arts where spraying and dipping are used to apply a film to a substrate that multiple layers can be applied by such processes (or even a combination of those processes).

The written description requirement is meant to assure that the claims do not overreach what has been invented, but the requirement does need mean reiteration of what is known in the art; rather it is a balance between what is known to the art and what is added. *Capon v. Eshhar*, 03-1480, 03-1481, \*14, \*16 (Fed. Cir., Aug. 12, 2005)(Fed. Cir. BBS).

Because various of the cited art references teach at least one coating, because coating multiple layers is well known in this and other art, and because

distinguishing the present invention from the cited art does not hinge on the number of coatings but rather the properties of the resulting product (which are elucidated in the present specification), this rejection should now be withdrawn.

Rejection of Calims 1, 2, 4, 6, 8, 11 and 12 under 35 U.S.C. §112[1]

This rejection alleges that specific disclosure regarding visible rays of an average reflectance of 15% or less (original claim 7), 12% reflectance (Ex. 1, Table 1), and 19% reflectance (Ex. 2, Table 1) does not provide a written description of "12% or more to 19% or less."

It is common knowledge that for a given wavelength the percentage each of transmittance + reflectance + absorption = 100%.

Original claim 1 (as well as page 2, lines 14-15, and other places in the specification) recites an average transmittance of 60% or more for visible light. Accordingly, the specification describes, for visible light, the combination of percentage reflectance + percentage absorption = 40%. Subtracting the reflectance and transmittance values for visible light for Examples 1 and 2 in Table 1 shows that the absorption in both cases is 7% (no change). The specification thus describes a reflectance of less than 33%, greater than the upper limit presently claimed.

In this case, the examiner alleges that there is only a description of 12-15% and 19% reflectivity.

It is only required, for example, that the specification describe the invention sufficiently for those of ordinary skill in the art to recognize that the applicant invented the subject matter he now claims. The PTO has the initial burden of presenting evidence or reasons why those skilled in the art would not recognize in the specification a description of the invention defined by the present claims.

As correctly pointed out by the Solicitor, the expression "at least 50%" crystal content does not literally appear in appellant's parent application. However, mere lack of literal support is not enough to carry the PTO's initial burden. Nor is this a situation

where the claims read on embodiments outside the scope of the description.

*In re Voss*, 557 F2d 812, 194 USPQ 267 (CCPA 1977) (citation omitted) (emphases added) (disclosure of 20-100% crystallinity sufficient disclosure of invention for claiming 50-100% crystallinity).

Appellants rely on the rationale of *In re Wertheim, supra*, as "clearly applicable here." Appellants urge that if a disclosure of 25-60% solids content taught those skilled in the art that 35-60% was part of the invention in Wertheim, although the latter range was not expressly mentioned therein, then appellants' disclosure of 60° C to 200° C in SN 159,159 would likewise teach 80° C to 200° C as part of appellants' invention. We agree with appellants that *Wertheim* is controlling on this point. We further note that in SN 159,159 appellants disclosed initially mixing the starting materials at a temperature up to 80° C prior to heating the reaction blend thus obtained to a maximum temperature of 200° C. We conclude that SN 159,159 adequately supports the limitation "80° C to 200° C" as recited in claims 7-12.

*In re Blaser*, 556 F2d 534, 194 USPQ 122 (CCPA 1977).

In the present case we note that Roberts discloses that the propellant may be from 10 to 79% of the product, "preferably 40 to 79% thereof and more preferably 40 to 60%" (application p. 20, lines 20 to 24); the 25% upper limit of the claimed range is not specifically disclosed. Nevertheless, applying the test enunciated in *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976), we are convinced that one of ordinary skill in the art, given Roberts' disclosure, would consider that use of the 10 to 25% range would be a part of his invention (see 191 USPQ at 98). Accordingly, the description requirement of 35 USC 112 is satisfied.

*McLaughlin v. Roberts*, 197 USPQ 831 (B.P.A.I. 1978) (emphasis added).

In this case, the examiner merely alleges that the specification does not specifically describe values between 15% and 19%. The written description requirement is only that the patent specification set forth enough detail to allow a person of ordinary skill in the art to understand what is claimed and to recognize that the inventor invented what is claimed. As stated in *Voss*, the PTO has the burden of explaining why one of ordinary skill in the art would not recognize in the specification what is claimed, and mere lack of literal support is not sufficient to

carry the burden. Thus even if there were experimental values of 16%, 17%, and 18% set forth in the specification, the examiner could argue that 16.5% and 17.5% were not described in the specification. This hypothetical shows that only a reasonable number of values need to be set forth to satisfy the written description requirement, as stated in *Wertheim* (where a range was narrowed), else the Office could always require additional values.

Therefore, as shown, the specification clearly teaches reflectances for visible light of less than 33%, of 19%, and from 15% to 12%, with 19% and 12% explicitly shown in working examples. There is no reasoning why one of ordinary skill in the art, given these explicit teachings, would not be apprised from reading the specification that applicants were in possession of a film having a reflectance of 12% to 19% for visible light. In *Wertheim*, a disclosure of 25-60% was a description of 35-60%; so in the present application a disclosure of less than 33%, coupled with specific experimental values of 12% and 19%, is a description of 12% to 19% inclusive. Because a reflectance of less than 33% is clearly disclosed, the recitation of 12% to 19% reflectance is not new matter. Accordingly, this rejection should now be withdrawn.